

REMARKS

The Official Action mailed April 4, 2005, entirely in the nature of a requirement for restriction, has been received and reviewed. Applicants respectfully request favorable reconsideration, withdrawal of the restriction requirement, and examination of all the claims on the merits.

Applicants have claimed the benefit of their corresponding provisional application 60/492,728, filed August 6, 2003. Acknowledgement thereof by the PTO would be appreciated.

Restriction has been required between two groups as outlined at the top of page 2 of the Official Action. As applicants must make an election even though the requirement is traversed, applicants hereby provisionally and respectfully elect Group I, presently claims 1-34, with traverse and without prejudice.

The restriction requirement is predicated on the assumption that the claimed method could be used to form a device which is other than and materially different from the claimed product, i.e. a device "without an external bias field". Respectfully, this is not correct, particularly in view of the amendments presented above in which the method claims have been made to depend from the elected device

claims. As it is a consistent rule, indeed a fundamental rule of claim interpretation, that all recitations which appear in a claim must be given consideration, and as applicants' method claims now specify that the method produces the device of Group I, it follows that the method "**as claimed**" cannot be used to make a different product, let alone one which is "**materially different**".

Accordingly, withdrawal of the requirement and examination on the merits of all the claims on this basis alone should be sufficient, and is respectfully requested.

Applicants note that the two groups are indicated in the Office Action to be separately classified. Even so, a complete search and examination of Group I would require a search in the locality of the classification of the method and a consideration of the method.

Accordingly, even though separate classification may exist, applicants respectfully submit that the restriction requirement should also be withdrawn on the basis of the second paragraph of MPEP 803, which **requires** examination of an entire application, even when the requirement is correct, if to do so would not constitute "serious burden". Because the method must in any way be searched and otherwise considered, applicants respectfully maintain that the second reason for

Appln. No. 10/743,268
Amd. dated May 4, 2005
Reply to Office Action of April 4, 2005

withdrawing the restriction requirement, i.e. the reason based on lack of "serious burden", also exists.

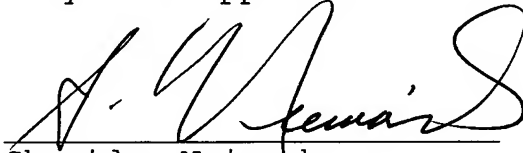
Again, applicants respectfully request withdrawal of the restriction requirement and examination of all the claims on the merits.

Applicants respectfully await the result of a first examination on the merits.

Respectfully submitted,

BROWDY AND NEIMARK, P.L.L.C.
Attorneys for Applicant

By


Sheridan Neimark
Registration No. 20,520

SN:jec
Telephone No.: (202) 628-5197
Facsimile No.: (202) 737-3528
G:\BN\C\cohn\Shvartsman1\pto\AMD 04 May 05.doc